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In re Application
Athwal et al.
Application No. 09/875,221
Filed: June 6, 2001
Attorney Docket No. CARP-0089

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: DECISION ON REQUEST FOR
: RECONSIDERATION OF DECISION
: ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
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This is a decision on the "RESPONSE TO DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT" filed October 7, 2004. Applicants request reconsideration of the decision mailed September 7, 2004. Applicants maintain that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to two hundred seventy-three (273) days, plus at least an additional 10 months of term adjustment due to delay in issuance.

The request for reconsideration of decision on application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is two hundred seventy - three (**273**) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 6, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 223 days. On August 6, 2003, applicants timely submitted an application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is two hundred seventy-three (273) days. This initial request by applicant presumably included an acknowledgment of entitlement to a patent term adjustment of 273 days on the basis that the USPTO failed to mail the first Office action, the Notice of Allowance, within 14 months of the filing date of the application¹.

¹ On request for reconsideration, applicants assert that the Decision incorrectly alleges that Applicants requested additional time on the USPTO's failure to mail the first Office Action or Notice of Allowance within 14 months of the filing date of the application. Whereas, the decision merely

Applicants only disputed the reduction of 50 days for applicant delay, associated with the delay in filing a response to the Notice to File Missing Parts of Application mailed July 18, 2001.

By decision mailed September 7, 2004, applicants were advised that the initial determination of patent term adjustment had been corrected to zero (0) days, including 273 days of Office delay and 449 days (not 50) of applicant delay. The applicant delay of 449 was entered pursuant to § 1.704(c)(7) for submitting an incomplete reply to the request to comply with sequence rules set forth in the Notice to File Missing Parts of Application mailed July 18, 2001. The entry of the 449 day period of reduction is at issue on instant request for reconsideration.

The application history has been carefully reviewed, and it has been determined that the entry of an additional period of reduction of 449 days was not warranted. A comparison of the Communications mailed by the Office and applicants' replies reveals that the relevant replies were neither non-compliant nor had an omission within the meaning of § 1.704(c)(7).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is two hundred seventy-three (273) days.

The application is being forwarded to the Office of Patent Publication for issuance of the application. The revised patent term adjustment indicated on the patent will include any additional patent term earned for Office failure to issue the patent within four months after the date the issue fee was paid and all outstanding requirements were satisfied.

Telephone inquiries specific to this decision should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Kery A. Fries

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of REVISED PALM Screen

acknowledged applicants' agreement with the 273 entry. Otherwise, there would have been no basis for applicants to assert entitlement to 273 days of PTA.